

REMARKS

By this Amendment, claims 1, 2, and 5-21 are pending, in which claims 1 and 2 are currently amended. No new matter is introduced. Applicants note that the amendments to claims 1 and 2 merely remove previously recited subject matter and, therefore, the present Amendment does not generate any new matter issue or any new issue for that matter requiring further consideration and/or search. It is, therefore, respectfully requested that the present Amendment be entered under 37 C.F.R. § 1.116.

The Final Office Action mailed May 5, 2009 rejected claims 1, 2, 5-12, and 20-21 under the second paragraph of 35 U.S.C. § 112 as indefinite, rejected claims 1 and 12 under 35 U.S.C. § 102(b) as anticipated by *Tanaka* (JP S63-9598Y2), rejected claim 2 under 35 U.S.C. § 102(b) as anticipated by *Yoshida* (EP 1462233), rejected claims 1, 2, 5, and 7-10 under 35 U.S.C. § 102(b) as anticipated by *Kochesky et al.* (US 5,284,704), rejected claims 1, 2, 5, and 7-10 under 35 U.S.C. § 103(a) as obvious over *Kochesky et al.*, rejected claim 6 under 35 U.S.C. § 103(a) as obvious based on *Kochesky et al.* in view of *Tanaka*, and rejected claims 11 and 13-21 under 35 U.S.C. § 103(a) as obvious based on *Kochesky et al.* in view of *Yoshida*.

In light of the amendments to the claims, the rejection of claims 1, 2, 5-12, 20, and 21 under the second paragraph of 35 U.S.C. § 112 as being indefinite is moot.

With respect to the rejection of claims 1 and 12 under 35 U.S.C. § 102(b) based on *Tanaka*, Applicants respectfully traverse this rejection for at least the reasons provided below.

Independent claim 1 recites, *inter alia*, “wherein said non-woven fabric is compressed at a temperature which is not lower than said softening temperature of said first component but lower than said softening temperature of said second component and is cooled, while maintaining compression, to a temperature lower than said softening temperature of said first component,

such that a solidified state of said first component restrains said second component in a compressed state to maintain an elastic restoring force of said second component.”

The Examiner, in response to Applicants arguments submitted January 26, 2009, asserts that the cited features of claim 1 are “not germane to the final product” because of the supposed “presence of process limitations on product claims in which the product does not otherwise patentably distinguish over the prior art,” (*See, e.g.*, Office Action, page 8). In drawing this conclusion, it is apparent that the Examiner has erroneously read certain structural features out of the claims, i.e., those structural features reasonably associated with a hot-press cushioning material comprising, *inter alia*, a first component and a second component, where “a solidified state of said first component restrains said second component in a compressed state to maintain an elastic restoring force of said second component.” Accordingly, Applicants respectfully submit that claims 1 and 12 are free of *Tanaka*.

It is well-settled that words of limitation that can connote with equal force a structural characteristic of a product or a process of manufacture for that product, “**are commonly and by default interpreted in their structural sense.**” *See, e.g., Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1379 (Fed. Cir. 2009); *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371 (Fed. Cir. 2003). In this manner, claim 1 structurally defines a hot-press cushioning material comprising a first component that restrains a second component in a compressed state, where the compressed state maintains an elastic restoring force of the second component.

These structural features are not disclosed by *Tanaka*. Namely, the applied reference merely teaches, in the fifth paragraph of the Translated Abstract, a cushioning material including a first fibrous layer comprising heat-resistant aromatic polyamide without use of a binding agent,

and a second fibrous layer comprising 6-6 nylon without use of a binding agent. Even though the first fibrous layer may include a longitudinal 6-6 nylon entanglement portion that is fused to the first fibrous layer, *Tanaka* is silent as to a first component restraining a second component **in a compressed state** or that the compressed state **maintains an elastic restoring force of the second component**.

Since the factual determination of lack of novelty under 35 U.S.C. § 102(b) requires the **identical disclosure** in a single reference of **each element** of a claimed invention, such that the **identically disclosed invention** is placed into the recognized possession of one having ordinary skill in the art, *Tanaka* fails to anticipate independent claim 1, as well as claim 12 dependent therefrom. See, e.g., *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Trintec Indus., Inc. v. Top U.S.A. Corp.*, 295 F.3d 1292, 1296-97 (Fed. Cir. 2002) (noting that the standard is strict, requiring **exact correspondence** between the contents of the applied reference and the claimed elements, such that **each and every element** recited in the claims is present in the allegedly anticipatory reference); *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002). Applicants, therefore, submit that the imposed rejection of claims 1 and 12 under 35 U.S.C. § 102(b) based on *Tanaka* is not viable and, hence, solicit its withdrawal.

With respect to the rejection of claim 2 under 35 U.S.C. § 102(b), Applicants also respectfully traverse this rejection.

Independent claim 2 recites, *inter alia*, “wherein said non-woven fabric is compressed at said softening temperature of said first component or higher and is cooled, while maintaining compression, to a temperature lower than said softening temperature of said first component, such that a solidified state of said first component restrains said second component in a compressed state to maintain an elastic restoring force of said second component.”

As with independent claim 1, the Examiner asserts that the cited features of claim 2 are also “not germane to the final product” because of the supposed “presence of process limitations on product claims in which the product does not otherwise patentably distinguish over the prior art,” (*See, e.g.,* Office Action, page 8). Applicants submit, however, that since claim 2 structurally defines a hot-press cushioning material comprising a first component that restrains a second component in a compressed state, where the compressed state maintains an elastic restoring force of the second component, and *Yoshida* fails to teach these features, claim 2 is also free of the applied reference. *See, e.g., Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1379 (Fed. Cir. 2009); *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371 (Fed. Cir. 2003).

More specifically, *Yoshida* merely discloses a cushioning pad for hot pressing including a non-woven fabric having two laminated fabric webs on the upper and lower faces of a base fabric, all of which may be integrated via needle-punching, (¶ [0023]). Even though the nonwoven fiber of *Yoshida* may be cooled **after compression** via a pressurizing plate, there is no express teaching that the final nonwoven fabric includes a first component that restrains a second component **in a compressed state**, or that the compressed state **maintains an elastic restoring force of the second component**.

Accordingly, *Yoshida* fails to provide an identical disclosure of each element of the hot-press cushioning material of claim 2 and, therefore, fails to place an identically disclosed invention into the recognized possession of one having ordinary skill in the art. *See, e.g., Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Trintec Indus., Inc. v. Top U.S.A. Corp.*, 295 F.3d 1292, 1296-97 (Fed. Cir. 2002) (noting that the standard is strict, requiring **exact correspondence** between the contents of the applied reference and the claimed

elements, such that **each and every element** recited in the claims is present in the allegedly anticipatory reference); *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002). Applicants, therefore, submit that the imposed rejection of claim 2 under 35 U.S.C. § 102(b) based on *Yoshida* is not viable and, hence, solicit withdrawal thereof.

Turning to the rejected of claims 1, 2, 5, and 7-10 under 35 U.S.C. §§ 102(b) and 103(a) based on *Kochesky et al.*, Applicants respectfully traverse each of these rejections, as well.

As previously demonstrated, claims 1 and 2 structurally provide for respective a hot-pres cushioning materials that comprise a first component that restrains a second component in a compressed state, where the compressed state maintains an elastic restoring force of the second component. Similarly to the other two rejections under 35 U.S.C. § 102(b), the Examiner maintains the position that the cited features of claims 1 and 2 are “not germane to the final product” because of the supposed “presence of process limitations on product claims in which the product does not otherwise patentably distinguish over the prior art,” (*See, e.g.*, Office Action, page 8). Based on the arguments proffered above, it is apparent that the features of claims 1 and 2 are in fact structural and, therefore, must be shown to be present or suggested by *Kochesky et al.*, which Applicants submit is not the case. *See, e.g., Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1379 (Fed. Cir. 2009); *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371 (Fed. Cir. 2003).

By contrast, *Kochesky et al.*, at best, merely teaches non-woven fibrous structures including 10 to 100% of bicomponent fibers characterized by a core polymer covered by a sheath polymer that are bonded together, (*See, e.g.*, Col. 2, line 41 – Col. 3, line 23). Like *Tanaka* and *Yoshida*, *Kochesky et al.* does not teach, or even remotely suggest, that either the sheath polymer restrains the core polymer (or the core polymer restrains the sheath polymer) in a compressed

state, much less that the compressed state maintains an elastic restoring force of the core polymer (or conversely the sheath polymer). Therefore, *Kochesky et al.* fails to provide an identical disclosure of each element of the hot-press cushioning material of claims 1 and 2, and, thus, fails to place an identically disclosed invention into the recognized possession of one having ordinary skill in the art. See, e.g., *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Trintec Indus., Inc. v. Top U.S.A. Corp.*, 295 F.3d 1292, 1296-97 (Fed. Cir. 2002) (noting that the standard is strict, requiring **exact correspondence** between the contents of the applied reference and the claimed elements, such that **each and every element** recited in the claims is present in the allegedly anticipatory reference); *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002). Applicants, therefore, submit that the imposed rejection of claims 1 and 2, as well as claims 5 and 7-10 depending from claim 1, under 35 U.S.C. § 102(b) based on *Kochesky et al.* is not viable and, hence, solicit withdrawal thereof.

Furthermore, the Examiner does not even argue that *Kochesky et al.* even remotely suggests a first component that restrains a second component in a compressed state, or that the compressed state maintains an elastic restoring force of the second component. Thus, a *prima facie* case for obviousness has not been established. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). Accordingly, the imposed rejection of claims 1 and 2, as well as claims 5 and 7-10 depending from claim 1, under 35 U.S.C. § 103(a) based on *Kochesky et al.* is also not viable and, hence, solicit withdrawal thereof.

Applicants likewise traverse the rejection of claim 6 under 35 U.S.C. § 103(a) based on *Kochesky et al.* in view of *Tanaka*.

Claim 6 is dependent from claim 2. Applicants incorporate the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102(b) based on

Tanaka and the arguments previously advanced in traversing the imposed rejection of claims 1 and 2 under 35 U.S.C. §§ 102(b) and 103(a) based on *Kochesky et al.* The additional comments provided by the Examiner on page 6 of the Office Action fail to cure the deficiencies of the attempted combination of *Kochesky et al.* and *Tanaka*, noting that the Examiner only additionally asserts that *Tanaka* “teaches the use of aromatic polyamide fibers with fibers such as polyamide and polyester.” Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite reasoning has been established, the claimed subject matter would not result. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). Based on the foregoing, Applicants submit that the imposed rejection of claim 6 under 35 U.S.C. § 103(a) is not sustainable, and hence, solicit its withdrawal.

Applicants also respectfully traverse the rejection of claims 11 and 13-21 under 35 U.S.C. § 103(a) based on *Kochesky et al.* in view of *Yoshida*.

Claims 11, 20, and 21 are dependent from claim 1. Applicants incorporate the arguments previously advanced in traversing the imposed rejection of claim 2 under 35 U.S.C. § 102(b) based on *Yoshida* and the arguments previously advanced in traversing the imposed rejection of claims 1 and 2 under 35 U.S.C. §§ 102(b) and 103(a) based on *Kochesky et al.* The additional comments provided by the Examiner on page 7 of the Office Action fail to cure the deficiencies of the attempted combination of *Kochesky et al.* and *Yoshida*, noting that the Examiner only additionally asserts that *Yoshida* “teaches lamination the nonwoven material to a woven fabric made of heat resistant fiber by needle punch” and “the production of a laminate such as a printed circuit board.” Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite reasoning has been

established, the claimed subject matter would not result. *See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). Based on the foregoing, Applicants submit that the imposed rejection of claims 11, 20, and 21 under 35 U.S.C. § 103(a) is not sustainable, and hence, solicit its withdrawal.

As for independent claim 13, and claims 14-19 depending therefrom, claim 13 recites, *inter alia*, “[a] **manufacturing method** . . . comprising . . . a step of cooling said non-woven fabric to a temperature lower than the softening temperature of said first component **in a compressed state**; and a step of **releasing the compressed state of said non-woven fabric after cooled**.” The Examiner did not address these features and, therefore, a *prima facie* case for obviousness has not been established. *See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). Even still, based on the arguments previously advanced, it is also clear that *Kochesky et al.* and *Yoshida*, whether taken alone or in combination, and Applicants do not agree that the requisite reasoning has been established to combine the references, fail to teach, or even remotely suggest, the claimed subject matter. Thus, a *prima facie* case for obviousness based on *Kochesky et al.* and/or *Yoshida* would never be sustainable. Accordingly, Applicants submit that the imposed rejection of claim 13, as well as claims 14-19 depending therefrom, under 35 U.S.C. § 103(a) is not sustainable, and hence, solicit its withdrawal.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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